

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SURYA RAGHU, DHARAPURAM N. SRINATH and SEAN T. BURNS

MAILED

JUL 08 2003

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2003-0733
Application No. 09/602,018

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 7, mailed December 1, 2001) of claims 1 to 5. Claim 6 has been allowed.¹ No claim has been canceled.

We AFFIRM-IN-PART.

¹ Claims 1, 2, 5 and 6 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to spa tub nozzles incorporating fluidic nozzles under submerged water conditions for obtaining massaging effects by the action of an oscillating jet of water (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|---------|-----------|--------------|
| Fichter | 3,776,460 | Dec. 4, 1973 |
| Bauer | 4,662,568 | May 5, 1987 |

Claims 2 to 5 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1 to 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bauer in view of Fichter.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer

(Paper No. 15, mailed September 3, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 14, filed June 28, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We sustain the rejection of claims 2 to 4 under 35 U.S.C. § 112, second paragraph, but not the rejection of claim 5.

In the final rejection (p. 3) and the answer (p. 3), the examiner set forth that claim 2 was indefinite since the recitation of "a pair of liquid outlet passages" in line 6 appeared to be a double inclusion of the "pair of outlet passages" recited in claim 1, line 8.

The appellants have not specifically contested this rationale for the rejection of claim 2 in the brief. Accordingly, we summarily sustain the rejection of claim 2, and claims 3 and 4 dependent thereon, under 35 U.S.C. § 112, second paragraph.

In the final rejection (p. 3) and the answer (p. 3), the examiner set forth that claims 2 and 5 were indefinite since the term "smoothly" is a relative term not defined in the specification.

The appellants argue (brief, pp. 5-7) that the term "smoothly" is explained in the specification (pp. 5-6) which states that the "outlet passages or channels CH1 and CH2 are preferably smooth without any sharp directional changes."

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

In our view, the metes and bounds of the term "smoothly" as used in claims 2 and 5 would be understood by a person of ordinary skill in the art to mean "without any sharp directional changes." As such, the term "smoothly" is definite as required by the

second paragraph of 35 U.S.C. § 112. Accordingly, we will not sustain the rejection of claim 5 under 35 U.S.C. § 112, second paragraph. However, the rejection of claim 2 under 35 U.S.C. § 112, second paragraph, has been sustained for the reasons set forth above.²

The obviousness rejection

We will not sustain the rejection of claims 1 to 5 under 35 U.S.C. § 103.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the

² In our view, claims 2 and 5 would be clearer if the phrase "to ambient" was deleted. In addition, the phrase "said reversing chamber" in claim 2 lacks proper antecedent basis. The appellants should correct these defects.

appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In the rejection of claims 1 to 5 under 35 U.S.C. § 103 before us in this appeal (answer, pp. 3-5), the examiner (1) set forth the pertinent teachings of Bauer and Fichter; (2) ascertained that Bauer does not disclose the use of his fluidic oscillator in a therapeutic spa tub; and (3) concluded that in view of Fichter's teaching of using a fluidic oscillator in a whirlpool bath, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used the fluidic oscillator of Bauer in a therapeutic spa tub for increased atomization.

The appellants argue (brief, pp. 7-9) that the applied prior art does not suggest using the fluidic oscillator of Bauer in a therapeutic spa tub. We agree. In our view, Fichter's teaching of using his fluidic oscillator in a whirlpool bath does not provide a

general teaching or suggestion to use every known fluid oscillator in a whirlpool bath or spa. The mere fact that the prior art could be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, the examiner's stated motivation for modifying Bauer (i.e., for increased atomization) does not come from the teachings of the applied prior art. Accordingly, we conclude that the only suggestion for modifying Bauer in the manner proposed by the examiner to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 5 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2 to 4 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject

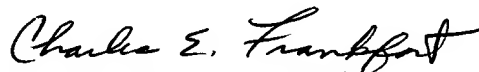
claim 5 under 35 U.S.C. § 112, second paragraph, is reversed; and the decision of the examiner to reject claims 1 to 5 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART



NEAL E. ABRAMS
Administrative Patent Judge



CHARLES E. FRANKFORT
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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